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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/253,793	02/22/1999	JEFFREY C. ROBISON	4164-P	6093

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EXAMINER

KEASEL, ERIC S

ART UNIT PAPER NUMBER

3754

DATE MAILED: 10/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/253,793

Applicant(s)

ROBISON ET AL.

Examiner

Eric Keasel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 13 to include recitations to "a device" with the device being what fastens the band retainer to the plug stem base. However, it appears that this "device" might be what applicant has been calling "a means for fastening said means for holding to said valve plug stem" because the "means for holding" includes the band retainer. It is vague and indefinite as to whether applicant is confusing this newly recited "device" with the "means for fastening" which has appeared in the claims of record since the application was filed and that the "device" and the "means for fastening" are meant to the same element, or perhaps the "device" is meant to be an entirely new element that was not disclosed in the application as filed (in which case, the claims would also be rejected under 35 USC 112 1st for new matter).

Depending on what is meant by "device", the bolts and pins as examples of the "means for fastening" in independent claims 15 and 17 may be at least partial double inclusions of the bolt and pin that are recited as possible "devices" in claim 13.

In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

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Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13, 16, and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Peters (US Patent Number 2,678,187).

Peters discloses a plug head assembly with a plug head (36), plug stem (31) with a base (30) having a cavity (see Fig. 3). A plug head band (41) is fitted between the plug head and a recessed portion of the cavity, a second side of the plug head band fits inside the recessed portion near ref. no. 39. The first side of the plug head band (41) with the flange (39a) is larger than the second side in the most recessed portion of the plug stem. A plug head band retainer (head of screw 42) fits over the plug head band and is fastened to the base portion of the valve plug stem by screw threads. The rubber plug head is a different material than the plug head band (41). Peters appears to anticipate claims 13, 16, and 20; however, given the indefinite nature of the claims, a single element of Peters may need to be modified into two elements to read on the claim. In such a case, Peters would not anticipate claims 13, 16, and 20. In the alternative

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interpretation of the claims, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modified a single element of Peters into more than element, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art (see MPEP 2144.04). Furthermore, one would be motivated to have multiple smaller parts rather than a single large part so that manufacturing the device would be easier in an environment without a large amount of space available to maneuver a single large part.

6. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters.

Peters fails to disclose a plurality of bolts and a plurality of nuts and also fails to disclose one or more pins. The examiner takes official notice that a plurality of bolts and a plurality of nuts and also one or more pins are well known equivalent means for fastening. It would have been an obvious matter of design choice to a person of ordinary skill in the art to have substituted either a plurality of bolts and a plurality of nuts or one or more pins because applicant has not disclosed that the exact means for fastening provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with a screw, a plurality of bolts and a plurality of nuts, or one or more pins because all these means for fastening are well known equivalents. Therefore, it would have been an obvious matter of design choice to modify Peters to obtain the invention as specified in claims 15 and 17.

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7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters as applied to claim 13 above, and further in view of Maier et al. (US Patent Number 4,325,647).

Peters fails to disclose the material selection design choices set forth in claims 18 and 19. Maier et al. disclose the use of a structural ceramic for the valve plug head and an alloy of aluminum and titanium for a similar plug head band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the material selection of a structural ceramic for the valve plug head and an alloy of aluminum and titanium for a similar plug head band, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Furthermore, Maier et al. also disclose that a motivation for using a ceramic and an alloy of aluminum and titanium would be for elasticity and insulation purposes (see the abstract).

Response to Arguments

8. Applicant's arguments with respect to claims 13 and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

EK 26SEP03
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26 Sep 2003


Gene Mancene
Supervisory Patent Examiner
Group 3700